



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------------|------------------------|
| 10/763,228 | 01/26/2004 | Kazuo Iida | 1506.1039 | 6546 |
| 21171 7590 05/21/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | EXAMINER PULLIAM, CHRISTYANN R | |
| | | | ART UNIT 2165 | PAPER NUMBER |
| | | | MAIL DATE 05/21/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,228

Applicant(s)

IIDA, KAZUE

Examiner

Christyann Pulliam

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8 are pending as filed January 26, 2004.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. The certified copy of the Japanese application is not in English and no translation was provided.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: S105 of Figure 4. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

Art Unit: 2165

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

5. Claim 6 is objected to because of the following informalities: "CGI" is ambiguous. The acronym "CGI" has multiple meanings even in the computer field. The term should be spelled out in the claims at its first use. Appropriate correction is required.

6. Claim 8 is objected to because of the following informalities: preamble is confusing. The phrase "to receive search results from the information retrieval sites" seems out of place. It is unclear what this phrase is intended to describe – the server or the terminal or something else. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Inconsistent reference to terms causes confusion as to whether or not the term refers to the same element as the prior use of the term. There is either an unclear antecedent basis or it appears to introduce another element of the same or almost the same name. Some examples include: information retrieval site(s), designation information retrieval site and each of information retrieval sites; script definition; predetermined sets of authentication information and authentication information; program; certification; authentication function; and conversion function. The first reference to an element should use the article "a" or "an" if singular or no article if plural. Later references to the same element should use the same term, same format of the term and either "the" or "said" since the element was introduced prior to this reference to it.

9. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Claim 2 begins with recoding authentication information. Issues arrive with the later steps of identifying and transmitting. Links between these steps

seem to be missing. First, it is unclear how or why "unassigned authentication information" would be identified. It is also unclear how "unassigned authentication information" seems to correspond to a site. Next, once the "unassigned authentication information" is identified the steps jump to transmitting the "identified authentication information". However, the only "identified authentication information" in the claim is the "unassigned authentication information". If the identified "unassigned authentication information" is unassigned then it is unclear how can it be transmitted to a site to get certification. Steps appear to be missing from Claim 2.

10. Claim 2 recites the limitation "the access number". There is insufficient antecedent basis for this limitation in the claim.

11. Claim 4 recites the limitation "the communication". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 5-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See MPEP § 2106-2106.02. Claim 8 lacks the necessary physical articles or objects to constitute a machine or a manufacture within

the meaning of 35 USC 101. It is clearly not a series of steps or acts to be a process nor is they a combination of chemical compounds to be a composition of matter. As such, it fails to fall within a statutory category. They are, at best, functional descriptive material *per se*. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). They can all be implemented in software alone. There is no proper computer-readable medium or hardware. The "means" of claim 8 can all be implemented in software. The "server" requires hardware in order to be statutory. Claims 5-7 need to be on computer program products that have code embodied on a computer readable medium which when executed cause the steps in the claims. Claims 5-7 need storage and execution. Accordingly, Claims 5-8 are not statutory.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al., U.S. Patent No. 6,807,539 (hereinafter Miller).

As for Claims 1, 5 and 8, Miller teaches:

recording a script definition in which a conversion function and an authentication function are defined for each of information retrieval sites into storage, said conversion function converting a description of a search condition in compliance with a predetermined description rule into a description in compliance with a description rule of an information retrieval site, and said authentication function being used for an authentication procedure of an information retrieval site that requires authentication as a condition to respond search results (See e.g. Miller – col. 5, line 62- col. 6, line 22 and col. 7, lines 21-31 and Figure 5);

reading a script definition corresponding to the information retrieval site designated by the user terminal from said storage (See e.g. Miller – col. 5, line 62- col. 6, line 48 and col. 7, lines 21-31 and Figure 5);

receiving certification from the information retrieval site by executing the authentication function when the script definition for the information retrieval site includes the authentication function (See e.g. Miller – col. 5, line 62- col. 6, line 48 and col. 7, lines 21-31 and Figure 5);

converting said search condition designated by the user terminal into a search condition in compliance with a description rule of the information retrieval site by executing the conversion function in the script definition (See e.g. Miller – col. 5, line 62- col. 6, line 22 and Figure 5);

transmitting a search request according to the converted search condition to the designated information retrieval site (See e.g. Miller – col. 6, lines 15-22 and Figure 5);

receiving search results from the information retrieval site that has retrieved information in response to said search request (See e.g. Miller – col. 6, lines 22-32 and Figure 5); and

transmitting the received search results to the user terminal (See e.g. Miller – col. 6, lines 42-48 and Figure 5).

As for Claim 2, Miller teaches the parent Claim 1. Miller also teaches further comprising:

recording predetermined sets of authentication information and ID information into said storage for each information retrieval site when the information retrieval site requires authentication and restricts the access number by assigning predetermined sets of authentication information to a source of an information retrieval request, said authentication information being assigned to said server by said information retrieval site, and said ID information identifying whether said authentication information is used or not (See e.g. Miller – col.8, line 30- col. 9, line 8);

identifying unassigned authentication information based on the ID information. read from said storage corresponding to said information retrieval site (See e.g. Miller – col.8, line 30- col. 9, line 8); and

transmitting the identified authentication information to said information retrieval site to receive the certification from said information retrieval site (See e.g. Miller – col.8, line 30- col. 9, line 8 and col. 7, lines 21-38).

As for Claim 3, Miller teaches the parent Claim 1. Miller also teaches further comprising: transmitting authentication information assigned by an information retrieval site to said information retrieval site according to an authentication function to receive certification from said information retrieval site when the script definition for said information retrieval site includes said authentication function (See e.g. Miller – col.8, line 30- col. 9, line 8 and col. 7, lines 21-38).

As for Claim 4, Miller teaches the parent Claim 1. Miller also teaches wherein the communication between said server and said user terminal, and the communication between said server and said information retrieval sites use TCP/IP and HTTP, respectively (See e.g. Miller – Figure 1 – Internet uses TCP/IP and col. 5, lines 45-55 – HTTP).

As for Claim 6, Miller teaches the parent Claim 1. Miller also teaches wherein said program is a CGI program (See e.g. Miller – Figures 3-4 and col. 8, line 30- col.9, line 8).

As for Claim 7, Miller teaches:

A cross-site search program running on a computer connected to a user terminal and a number of information retrieval sites through a network, said program causing said computer to execute the procedures of:

accepting designation of any one of said information retrieval sites with a search condition by said user terminal (See e.g. Miller – col. 2, lines 35-40);

identifying a script definition corresponding to the designated information retrieval site among a number of script definitions, said script definition defining a conversion function that converts a description of a search condition in compliance with a predetermined description rule into a description in compliance with a description rule of an information retrieval site (See e.g. Miller – col. 2, lines 40-65 and col. 5, line 62- col. 6, line 22 and Figure 5);

receiving certification from the information retrieval site by executing an authentication function when the script definition for said information retrieval site includes said authentication function (See e.g. Miller – col. 5, line 62- col. 6, line 48 and col. 7, lines 21-31 and Figure 5);

converting the search condition designated by the user terminal into a search condition in compliance with a description rule of the information retrieval site by executing the conversion function in the script definition (See e.g. Miller – col. 5, line 62- col. 6, line 22 and Figure 5);

transmitting a search request according to the converted search condition to the designated information retrieval site (See e.g. Miller – col. 6, lines 15-22 and Figure 5);

receiving search results from the information retrieval site that has retrieved information in response to said search request (See e.g. Miller – col. 6, lines 22-32 and Figure 5); and

transmitting the received search results to the user terminal (See e.g. Miller – col. 6, lines 42-48 and Figure 5).

Conclusion

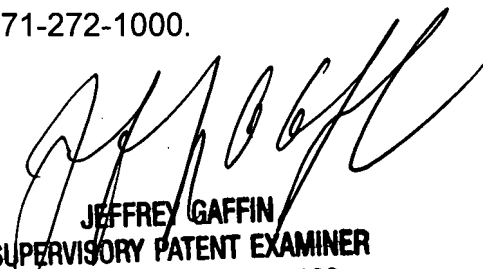
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christyann Pulliam whose telephone number is 571-270-1007. The examiner can normally be reached on M-Th 8:30am-6pm, every other Fri 8:30am-5pm EST.

Art Unit: 2165

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRFP
CRFP


JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100